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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,604	03/20/2001	Larry Leighton	257/265	3015

7590

01/12/2004

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EXAMINER
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MONDT, JOHANNES P

ART UNIT	PAPER NUMBER
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2826

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/813,604	<b>Applicant(s)</b> LEIGHTON ET AL.	
	<b>Examiner</b> Johannes P Mondt	<b>Art Unit</b> 2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/04/2003 has been entered.

### ***Response to Amendment***

Amendment filed 11/04/2003 has been entered based on aforementioned Request for Continued Examination and forms the basis of this Office Action. In said Amendment Applicant amended claims 5-8 through substantial amendment of claim 5. Comments on Remarks in said Amendment are included below under "Response to Arguments".

### ***Response to Arguments***

2. Applicant's arguments filed 11/04/2003 have been fully considered but they are not persuasive. In particular, Applicant's argument on page 6 that "the chronological order in which the transistor, the input signal lead or the input matching element are secured to the substrate does not matter" (lines 1-2) is irrelevant to the grounds as provided for the rejections of claims 1-8 under 35 USC 112, first paragraph. Indeed,

while it is agreed that the order in which the transistor, the input (or output, for claim 5) lead or the input (or output, for claim 5) matching element are secured to the substrate does not matter within the context of the language of the independent claims, step (1) as defined by either claims 1 or 5 does imply that the act of securing the die to the substrate takes place while said die comprises said transistor and while said substrate comprises said input matching element and said (at least) one input matching element. In other words, while Applicant traverses by arguing irrelevance of the chronological order of securing (a) said transistor, (b) said input signal lead or (c) said (at least) one input matching element, the implication of the non-originals claims 1 and 5 that prompted the said rejection concerns the chronological order of (A) securing the die to the substrate and (B) securing the transistor (to the die) and the input signal lead and the (at least one) input matching element (to the substrate). In particular, step (1) recited in either claim 1 or claim 5 implies that (B) must have preceded (A). Therefore, Applicant is invited to once again consider the claim language in this regard, particularly in view of the lack of disclosure in the original Specification (including the original claim language) of the chronological priority of (B) over (A).

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-8** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, nothing in the Specification (including the original claims) discloses that as a first step a die is to be secured to a substrate while said substrate already comprises at least one input matching element and at least one input signal lead; yet, this is the logical implication of step 1 as formulated in claim 1 and in claim 5.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P Mondt whose telephone number is: 703-306-0531 BEFORE February 4, 2004; and 571-272-1919 AFTER February 4, 2004. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J Flynn can be reached on 703-308-6601 BEFORE February 4, 2004, and on 571-272-1915 AFTER February 4, 2004. The fax phone number for the organization where this application or proceeding is assigned is 703-308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JPM  
January 8, 2004

  
**Minhloan Tran**  
**Primary Examiner**  
**Art Unit 2826**